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62

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,836	08/02/2001	Douglas A. Newberg	2153-0116P	4362

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EXAMINER

CROSS, LATOYA I

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 01/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/919,836

Applicant(s)

NEWBERG, DOUGLAS A.

Examiner

LaToya I. Cross

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 10, 12, 14-21 and 23-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-17, 20, 21, 31-34 and 36-40 is/are allowed.
- 6) ☒ Claim(s) 10, 12, 18, 19, 27-29 and 35 is/are rejected.
- 7) ☒ Claim(s) 23-26 and 30 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This Office Action is in response to Applicants' amendment filed on October 29, 2003.

Claims 10, 12, 14-21 and 23-40 are present in the application.

### DETAILED ACTION

#### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 10, 12, 18, 19, 27-29 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by European publication EP 0913465 to Hashimoto et al.

Hashimoto et al teach an automated sampling system comprising a sealed first partition chamber R (equivalent to Applicants' housing) enclosing a robot device E (equivalent to Applicants' conveyor). The first partition chamber comprises a sealable input port for work base entry from work base stocker S (equivalent to Applicants' claimed empty receptacle holder) and a sealable output port G5 for work base exit to a different work base stocker S (equivalent to Applicants' claimed filled receptacle holder) positioned on the other side of the partition chamber R (Figures 38 and 39). Each of the stockers is removably mounted to the partition chamber such that the environment inside the partition chamber and the environment inside the receptacle holder remain sealed from each other and the ambient environment outside the partition chamber. The work base is movable from the empty receptacle holder into the partition chamber and filled with a flowable material via a flowable material supplier F8,

and then moved to the filled receptacle holder to be removed therewith. Additionally, Hashimoto et al teach disinfectant spray devices G6 inside the chamber S and the robot chamber R being operable to supply a flowable material (e.g. sterilizing agent) into the interior of the chambers. See col. 39, line 24 – col. 42, line 58.

### *Response to Arguments*

3. Applicant's arguments filed October 29, 2003 have been fully considered but they are not persuasive. In response to the rejection over Hashimoto et al, Applicants argue that the reference fails to teach a filled receptacle holder being removably mounted to a housing such that when the filled receptacle holder and housing are removed from one another, the environment inside the housing and the environment inside the receptacle holder are sealed from one another and from the ambient environment outside the housing.

The Examiner would like to point out that the limitation of "when said filled receptacle holder and said housing are removed from each other" is a functional limitation. In claims directed to an apparatus, the manner in which the apparatus operates is insufficient to overcome prior art that teaches the same structural limitations claimed by Applicants. See MPEP 2114. Applicants must incorporate structural limitations into the claims that distinguish the claimed invention from that of the prior art.

### *Allowable Subject Matter*

4. Claims 14-17, 20, 21, 31-34 and 36-40 are allowed.

5. Claims 23-26 and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The reasons for indicating allowable subject matter may be found in the previous Office Action.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaToya I. Cross whose telephone number is 571-272-1256. The examiner can normally be reached on Monday-Friday 8:30 a.m. - 5:00 p.m..

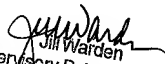
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 571-272-1267.

Art Unit: 1743

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Examiner.

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January 2, 2004

  
Jill Warden  
Supervisory Patent Examiner  
Technology Center 1700